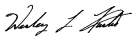


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/Wesley L. Austin/

Attorney for Applicants

PATENT APPLICATION

Docket No. SLA1081

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jeff S. Vigil et al.

Serial No.: 09/928,856

Filed: August 13, 2001

For: ENHANCED TEXT ENTRY SYSTEM FOR
WIRELESS DEVICES

Examiner: Tadesse Hailu

Group Art
Unit: 2173

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

An Office Action dated April 21, 2006 rejected all pending claims (claims 1-3, 7-19, 23-34 and 37-40) in the present application. A timely Notice of Appeal was mailed on July 21, 2006 and was received by the United States Patent Office on July 24, 2006. Appellants' Appeal Brief is being filed herewith.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Sharp Laboratories of America, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences.

3. STATUS OF CLAIMS

Claims 1-3, 7-19, 23-34 and 37-40 are pending in the present application. Claims 4-6, 20-22, 35 and 36 have been cancelled. Claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,908,389 to Puskala (hereinafter, "Puskala") in view of U.S. Patent Publication No. 2002/0174106 to Martin (hereinafter, "Martin"). Claims 9-12, 25-28 and 38-40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Puskala in view of U.S. Patent Publication No. 2002/0178353 to Graham (hereinafter, "Graham").

Appellants appeal the rejections of claims 1-3, 7-19, 23-34 and 37-40.

4. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection.

5. SUMMARY OF INVENTION

As stated in the background section, wireless devices have enabled users to browse the Web and send and receive messages, including email messages, from a variety of locations with only their hand-held wireless telecommunications device. The demands of consumers to be able to easily and quickly communicate with others continues to grow. See Appellants' patent application (hereinafter referred to as the "Specification"), page 2, lines 1-4.

User input components of hand-held wireless devices usually do not have the same capabilities as other user input components. For example, a cell phone only has a limited number of keys and, as a result, it often takes a user much longer to compose an email message using a cell phone than it would on a personal computer. Similarly, the handwriting recognition hardware and software typically used by personal digital assistants usually takes longer to enter a message than if a keyboard were used. Consequently, many wireless devices used for sending messages may benefit from being able to more easily enter or provide messages to be sent to recipients.

Specification, page 2, lines 6-13.

As required by 37 C.F.R. § 41.37(c)(1)(v), a summary of claimed subject matter immediately follows. The references to the specification refer only to embodiments of the invention. The invention is defined by the claims. Accordingly, these references to the specification are not meant to limit the scope of the claims of the present invention in any way but are only provided because they are mandated by 37 C.F.R. § 41.37(c)(1)(v). All references are to the patent specification.

1. A hand-held wireless telecommunications device configured to send a text message to a recipient through use of a global computer network, the wireless device comprising:

- a processor (pg. 2, line 18; pg. 10, lines 20-24; pg. 15, line 3; pg. 22, lines 7-9; and Figure 7, element 702);

- an input component in electronic communication with the processor for a user to enter user input, wherein the input component is capable of entering text (pg. 2, lines 17-19; pg. 10, line 20 through pg. 11 line 2; pg. 15, lines 4-5; pg. 22, lines 7-9; Figure 7, element 704; Figure 9, element 904);

- a display in electronic communication with the processor that displays information to the user (pg. 2, lines 19-20; pg. 11, lines 3-5 and lines 22-29; pg. 12, line 24 through pg. 13, line 4; pg. 15, lines 6-7; pg. 22, lines 7-9; Figure 7, element 706; and Figure 9, element 906);

- a communications module in electronic communication with the processor (pg. 2, lines 20-22; pg. 11, lines 11-16; pg. 15, lines 8-9; pg. 22, lines 7-9; and Figure 7, element 710) for communicating with the global computer network (pg. 6, line 14 through pg. 7, line 4; pg. 22, lines 7-9; and Figure 1, element 106);

memory in electronic communication with the processor for storing data (pg. 3, lines 22-23; pg. 11, lines 7-10; pg. 15, line 10; pg. 22, lines 7-9; and Figure 7, element 708), wherein the data comprises at least one token (page 3, lines 10-12; page 9, line 28 through pg. 10, line 13; pg. 13, lines 27-28; page 16, lines 7-8; and Figure 6, elements 606 and 608);

a messaging module (pg. 2, lines 24-25; pg. 11, lines 19-21; pg. 22, lines 9-11; and Figure 7, element 708) comprising instructions that are executable by the processor for implementing a method comprising:

connecting the wireless device to the global computer network (pg. 2, lines 25-26; pg. 13, lines 6-7 and lines 15-16; pg. 22, lines 9-10; pg. 22, lines 9-11; Figure 10, element 1002; and Figure 11, element 1102);

displaying network data received from the global computer network on the display (pg. 2, lines 25-28; pg. 15, lines 14-15)

enabling the user to establish communications with a message web site (pg. 2, lines 25-28; pg. 6, line 28 through pg. 7, line 1; pg. 15, line 16)

providing to the user a message user interface to select a message from a plurality of preconfigured messages (pg. 2, line 29 through pg. 3, line 1; pg. 9, lines 9-11; pg. 12, lines 1-6; pg. 12, lines 26-27; pg. 15, lines 18-19), each of the plurality of messages being preconfigured to be sent to a recipient (pg. 2, lines 5-11; pg. 9, lines 4-6; pg. 10, lines 4-14; and Figure 8-9), wherein at least one of the messages is a text message that includes at least one token (pg. 3, lines 10-12; pg. 9, line 28 through pg. 10, line 14; pg. 13, lines 25-28; pg. 16, lines 7-8; Figure 6), wherein the messaging module receives the plurality of preconfigured messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of preconfigured messages (pg. 3, lines 1-4; pg. 9, lines 17-27; pg. 15, lines 18-23; and Figures 3-5), and wherein the messaging module allows the user to enter token text to replace the at least one token in the message (pg. 3, lines 10-12; pg. 13, lines 27-28; pg. 16, lines 10-11; and Figure 11, element 1114);

providing to the user a recipient user interface to select the recipient (pg. 2, lines 25-28; pg. 12, line 22 through pg. 13, line 4 and lines 23-24; and Figure 11, element 1108); and
sending the message to the recipient through the global computer network (pg. 2, lines 4-5; pg. 13, line 28 through pg. 14, line 1; pg. 15, line 24; and Figure 11, element 1116).

13. A web site for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices, the web site comprising:

- a web server for serving web data to a plurality of wireless devices (pg. 3, lines 13-16);
- a computer enabling operation of the web server (pg. 3, lines 13-16;), the computer being in electronic communication with a storage device storing instructions executable by the computer for implementing a method (pg. 3, lines 16-17;) comprising:
 - allowing a wireless device to contact the web site via a global computer network (pg. 3, lines 17-20; pg. 6, line 28 through pg. 7, line 1; pg. 15, line 16; pg. 13, lines 6-7 and lines 15-16; pg. 22, lines 9-10; pg. 22, lines 9-11; Figure 10, element 1002; and Figure 11, element 1102);
 - receiving from the wireless device a user identification (pg. 3, lines 17-20; pg. 9, lines 17-27; pg. 15, lines 18-23; and Figures 3-5);
 - sending an address list identified through use of the user identification from the web site to the wireless device (pg. 3, lines 17-20; pg. 9, lines 17-27; pg. 15, lines 18-23; and Figures 3-5);

sending a plurality of preconfigured messages identified through use of the user identification from the web site to the wireless device (pg. 3, lines 20-22;), each of the plurality of messages being preconfigured to be sent to a recipient (pg. 2, lines 5-11; pg. 9, lines 4-6; pg. 10, lines 4-14; and Figure 8-9), wherein at least one of the preconfigured messages is a text message that includes at least one token (pg. 3, lines 10-12; pg. 9, line 28 through pg. 10, line 14; pg. 13, lines 25-28; pg. 16, lines 7-8; and Figure 6), and wherein at least one token is editable by the user using the wireless device (pg. 3, lines 11-12; pg. 10, lines 2-3 and 4-14; pg. 13, lines 27-28; pg. 16, lines 10-11; cancelled claim 22; and Figure 11, element 1114);

receiving a message and the recipient from the wireless device (pg. 3, line 23 and pg. 17, line 8), wherein the message is selected from the preconfigured messages by a user through the wireless device (pg. 3, lines 23-24; pg. 9, lines 17-27; pg. 15, lines 18-23; and Figures 3-5), and wherein the recipient is selected from the address list by the user through the wireless device (pg. 3, lines 24-25; pg. 8, lines 26-28; pg. 13, lines 22-24; and Figure 11, element 1108); and

sending the message to the recipient through the global computer network (pg. 3, lines 25-26; pg. 13, line 28 through pg. 14, line 1; pg. 15, line 24; and Figure 11, element 1116).

29. A method for providing preconfigured messages to a hand-held wireless telecommunications device to be sent to a recipient through use of a global computer network, the method comprising:

establishing electronic communication between the wireless device and the global computer network (pg. 4, lines 9-11);

establishing electronic communication between the wireless device and a web site storing preconfigured messages (pg. 4, lines 9-11; pg. 13, lines 6-7 and lines 15-16; pg. 22, lines 9-10; pg. 22, lines 9-11; Figure 10, element 1002; and Figure 11, element 1102), each of the messages being preconfigured to be sent to a recipient (pg. 2, lines 5-11; pg. 9, lines 4-6; pg. 10, lines 4-14; and Figure 8-9), wherein at least one of the messages is a text message that includes at least one token (pg. 3, lines 10-12; pg. 9, line 28 through pg. 10, line 14; pg. 13, lines 25-28; pg. 16, lines 7-8; and Figure 6), and wherein at least one token is editable by the user using the wireless device (pg. 3, lines 10-12; pg. 13, lines 27-28; pg. 16, lines 10-11; and Figure 11, element 1114);

retrieving an address list from the web site based on a user identification (pg. 4, lines 11-12; pg. 9, lines 17-27; pg. 15, lines 18-23; and Figures 3-5);

sending the address list to the wireless device (pg. 4, lines 12-14; pg. 8, lines 25-28; pg. 9, lines 17-27; pg. 15, lines 18-23; and Figures 3-5);

providing to a user a recipient user interface to select the recipient from the address list (pg. 4, lines 12-14; pg. 12, line 22 through pg. 13, line 4 and lines 23-24; and Figure 11, element 1108);

retrieving the preconfigured messages from the web site based on a user identification (pg. 4, lines 12-14; pg. 13, lines 9-11; and Figures 3-5);

sending the preconfigured messages to the wireless device (pg. 4, lines 14-15; pg. 9, lines 9-11; pg. 12, lines 1-6; pg. 12, lines 26-27; and pg. 15, lines 18-19);

providing to the user a message user interface to select a message from the preconfigured messages (pg. 4, lines 15-17; pg. 9, lines 9-11; pg. 12, lines 1-6; pg. 12, lines 26-27; and pg. 15, lines 18-19), wherein if the message includes a token, the message user interface allows the user to input token text (pg. 4, lines 15-17; pg. 13, lines 27-28; pg. 16, lines 10-11; and Figure 11, element 1114); and

sending the message to the recipient through the global computer network (pg. 4, lines 15-17; pg. 13, line 28 through pg. 14, line 1; pg. 15, line 24; and Figure 11, element 1116).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following issues are presented for review:

A. Whether claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 are unpatentable under 35 U.S.C. § 103(a) over Puskala in view of Martin.

B. Whether claims 9-12, 25-28 and 38-40 are unpatentable under 35 U.S.C. § 103(a) over Puskala in view of Graham.

7. ARGUMENT

A. Claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 Rejected under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 under 35 U.S.C. § 103(a) over Puskala in view of Martin. This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Appellants respectfully submit that the claims at issue are patentably distinct from Puskala in view of Martin. Neither Puskala nor Martin discloses, teaches, or suggests all of the limitations in the claims.

Claims 1, 13 and 29 recite “at least one of the ... messages is a text message that includes at least one token.” Claim 1 also recites that a “messaging module allows the user to enter token text to replace the at least one token in the message.” Claims 13 and 29 recite “at least one token is editable by the user using the wireless device.” Appellants respectfully submit that Puskala does not disclose, teach, or suggest these claim limitations; that Martin likewise does not disclose, teach, or suggest these claim limitations; and that the proposed combination of Puskala and Martin is improper because Puskala teaches away from Martin. These arguments will be discussed sequentially below.

First, Appellants submit that Puskala does not disclose, teach, or suggest these claim limitations. In the Office Action of November 12, 2006 (hereinafter, “Third Office Action”), the Examiner admitted that “Puskala does not describe that the message is a text message that includes a token. Puskala further fails to describe that the messaging module allows the user to enter token text to replace the token in the message.” Third Office Action, pages 9-10. Appellants agree with the Examiner and respectfully submit that in addition to not disclosing, teaching, or suggesting the use of tokens, as recited in claims 1, 13 and 29, Puskala teaches away from their inclusion or use, as will be discussed below.

Second, Appellants submit that Martin does not disclose, teach, or suggest these claim limitations. Specifically, Martin does not disclose, teach, or suggest that “the user [may] enter token text to replace the at least one token in the message,” as recited in claim 1, or that “at least one token is editable by the user,” as recited in claims 13 and 29.

In the Office Action, the Examiner asserts that Martin discloses “placeholder tokens.” See the Office Action of April 21, 2006 (hereinafter, “Fourth Office Action”), pages 4-5. The Examiner argues the following:

Martin, however, discloses a connector (a software component) that includes a template, which may include some specific actions/text, and placeholder tokens for data to be added by the placeholder tokens are the vehicle by which user input and “real time” data and context are transferred from a client to an agent. For one placeholder embodiment, placeholder tokens also determine when a connector is selected (Par. 65). The placeholder tokens are replaced with their associated data. Placeholder may include run time data such as current date, current time, client id, user input arguments, categories, etc. This data is characterized

as anything that would logically need to be chosen by a client (as opposed to static reference data). The client includes all potential placeholder tokens and has routines that can supply the correct replacement data.

See id. Apparently the Examiner is asserting that Martin's "placeholder tokens" are the same as the tokens that may be replaced with "token text" entered by the user or edited by the user, as recited in claims 1, 13 and 29. Appellants submit that Martin does not disclose, teach, or suggest that the "placeholder tokens" may be replaced with "token text" entered by the user or edited by the user, as recited in claims 1, 13 and 29. Rather, Martin discloses that the "placeholder tokens" are "specially flagged text that are replaced by the dispatcher in a client software prior to the dispatcher" sending a message to an agent or that the "placeholder tokens" are "filled with data" by the client or agent. See Martin, page 4, paragraphs [0066]-[0070]. However, the dispatcher, client and agent are not users, as recited in claims 1, 13 and 29. Rather, the dispatcher, client and agent are software modules.

For example, Martin discloses that the dispatcher is a part of the client software that "is invoked when the user has entered a request" such as "clicking on the Send button." See Martin, page 3, paragraphs [0031] and [0033]. Martin discloses that the client is a platform that includes various client applications. See id. at page 1, paragraph [0019]. Martin further discloses that "[a]gents are independent autonomous software programs that can run on the user's client platform, on a dedicated server, on any other server, or on any combination of the above." Id.

Though Martin discloses that "[t]he user may type, speak, write, or otherwise convey a request into the console," Martin does not disclose, teach, or suggest that "the user [may] enter token text to replace the at least one token in the message," as recited in claim 1, or that "at least one token is editable by the user," as recited in claims 13 and 29. Appellants respectfully submit that Martin's "placeholder tokens" are merely variables that may be replaced by a dispatcher, client, or agent.

Finally, the proposed combination of Puskala and Martin is improper because Puskala teaches away from Martin. The M.P.E.P. states that "[a] prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. M.P.E.P. § 2144.05 citing In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). In fact, if there is such "teaching away" in a reference, then this "finding

alone” defeats any assertion of obviousness under § 103(a). See Winner Int’l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). This is because “[i]t is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145 citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The Federal Circuit has held that a reference teaches away from a claimed invention when the reference leads its reader “in a direction divergent from the path that was taken by the applicant.” Tec Air, Inc. v. Denso Mfg. Mich. Inc., 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

The Examiner’s asserted motivation to combine Puskala and Martin is that the combination “will enhance the editing and sending of the text messages.” Third Office Action, page 10. However, this assertion is in direct conflict with Puskala. Puskala discloses the use of predefined messages for wireless multiplayer gaming. A straight-forward reading of Puskala makes it clear that the purpose of the invention is to prevent interruptions to multi-player gameplay. Because the purpose of Puskala is to prevent interruptions to multi-player gameplay, Puskala only discloses the use of entirely predefined messages, and not tokens, as recited in claims 1, 13 and 29, because entering text during gameplay would interrupt the game.

Puskala discloses various advantages of the use of predefined messages over messages created during gameplay. For example, Puskala discloses that one advantage of predefined messages is that “when the same content is to be sent multiple times to one or many recipients[,] ... it is unnecessary to repeatedly recreate the content of those messages.” Puskala, col. 1, lines 18-21. Puskala discloses that predefined messages include the advantages of:

...reduc[ing] the load placed on the network by the sending of messages because the sender must only send a predefined command, rather than a textual message, and the network only has to recognize and process the known command by selecting which predefined message to send and to whom to send it.

Id. at lines 21-27.

Puskala also discloses various disadvantages of creating message text during gameplay. For example, Puskala asserts that “[i]t is often difficult for a player to define a message to be sent while playing a game because the game often fills the entire relatively small display on the mobile terminal.” Id. at lines 43-46. Additionally, Puskala states that “using a portion of the display to prepare a message to be sent will cover a substantial portion, if not all, of the game

screen, making it difficult or impossible to see the game while communicating.” Id. at lines 46-50. Furthermore, because mobile phones “usually only have numeric keypads and possibly a few special feature buttons that can be used to enter messages ... [e]ntering messages by typing on a keyboard can be a slow process and can interrupt the game.” Id. at lines 57-58. Consequently, “[w]here at least some of the messages are player-defined, it is preferable to define the messages at a time other than during the playing of a game so that it is not necessary to disrupt the game to create a message and to customize the messages that are sent.” Id. at col. 7, lines 38-42.

Puskala teaches away from entering message text during gameplay, because Puskala would lead one of skill in the art at the time the invention was conceived “in a direction divergent from the path that was taken by the applicant.” Because customization requires typing on a numeric keypad, which is “a slow process” that “can interrupt the game,” and because the “prepar[ing] a message to be sent will cover a substantial portion, if not all, of the game screen, making it difficult or impossible to see the game while communicating,” Puskala clearly teaches away from any customization of its predefined messages including the use of tokens as recited in claims 1, 13 and 29.

Further, it is well settled that if the proposed modification/combination would render one of the references unsatisfactory or inoperable for its intended purpose, then these references teach away from their combination and make an obviousness rejection improper. MPEP § 2143.01; In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (holding that where the proposed combination/modification would cause the device outlined by the reference to become inoperable for its intended purpose, then this modification is improper and cannot be made.)

The intended purpose of Puskala is to prevent interruptions to gameplay by using predefined messages. However, Appellants submit that the use of tokens, as shown above, would interrupt gameplay thereby rendering Puskala at least unsatisfactory for its intended purpose of preventing such interruptions. Therefore, in addition to being divergent from the teachings of Puskala, the use of tokens would also render Puskala unsatisfactory for its intended purpose. Consequently, Puskala teaches away from the Examiner’s proposed combination. Thus, Puskala cannot be combined with Martin or any reference for the purpose of customizing

predefined messages especially the use of tokens, as recited in claims 1, 13 and 29. In fact, Puskala not only teaches away from the use of tokens, as recited in claims 1, 13 and 29, but the use of tokens with Puskala's predefined messages for multiplayer gaming would destroy the very purpose of the invention in Puskala, because it would interrupt gameplay. Therefore, because Puskala teaches away from these claim elements, Puskala cannot be combined with Martin to render claims 1, 13 and 29 unpatentable.

In response to these arguments, the Examiner asserts the following:

In contrast to the applicants' argument [sic] Puskala in view of Martin is directed to the same invention as the current invention, [sic: and] Puskala in view of Martin also teaches the placeholder tokens that are edited, [sic: and] replaced with their associated data by the user (Martin, Par. 77). Both the current invention and the prior art of records [sic: record] (Puskala and Martin) are directed in [sic: to] minimizing the [sic] user entry when manipulating a message sing [sic: messaging] placeholder token. The incorporation of said token minimizes the number of clicks required by the user interface when manipulating a message.

Fourth Office Action, page 14. Appellants respectfully submit that this assertion does not rebut Appellants' argument; if Puskala teaches away from Martin, then this combination is improper.

Additionally, Appellants submit that the claimed invention must be considered as a whole. M.P.E.P. § 2143. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. Id. The Examiner has not considered the references as a whole. As pointed out above, when the references are considered as a whole it is clear that not only is there no motivation to combine the two, but any combination of the placeholder tokens of Martin with Puskala would destroy the very purpose of Puskala. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The Examiner further asserts "the applicants are dubious at best when they base their arguments on the Background disclosure of Puskala. Puskala is an improved invention over what is described in the Background of Puskala's invention." Fourth Office Action, page 15. Appellants respectfully submit that the location of the statements that teach away from combining a reference is not relevant to patentability. See Ex Parte Dileep Bhagwat et al.,

Appeal No. 2003-1424 (B.P.A.I. 2003) (Non-Precedential) (Finding the Examiner's proposed combination improper based on the statements in the background section of the prior art reference). Furthermore, the purposes for the improvements disclosed by Puskala would be destroyed by the Examiner's proposed combination.

The Examiner asserts that Puskala discloses other teachings that teach toward the use of tokens, as recited in claims 1, 13 and 29. Specifically, the Examiner asserts "[i]n contrast to the applicants' argument, Puskala disclose modification/customization of user data, user can edit (via input means) his/her own USER-DEFINED MSG and send it to the target player." Fourth Office Action, pages 15-16 (internal citations omitted). In support of this assertion, the Examiner cites the following portion of Puskala:

Message 4 is reserved in this example for a user-defined message. The players to whom a predefined message are [sic: is] to be sent may be selected from a similar menu that may be displayed. Generally, the players to whom the message is sent may be designated with a default setting so that the number of clicks required by the user interface is kept to a minimum.

Puskala, col. 9, lines 38-44. Appellants respectfully submit that this "user-defined message" is merely a message that is predefined by the user rather than by the device (*i.e.* Messages 1-3). This cited portion of Puskala is referring to Figure 5A. Puskala discloses that Figure 5A "depicts a mobile phone displaying a sample menu of predefined messages available to be sent by a mobile phone user by entering a corresponding code from the keypad." Puskala, col. 3, lines 61-64. Consequently, the "user-defined message" is not a "token," as recited in claims 1, 13, 29, but is merely a message that is predefined by the user prior to gameplay.

The Examiner also asserts that "[a] player can receive messages while offline from the gaming system without interrupting his game." Fourth Office Action, page 16. In support of this assertion, the Examiner cited the following portion of Puskala:

A player who is sent game-related predefined messages can arrange to have some or all of the predefined messages he receives while offline from the gaming system or while at a terminal that is not WAP-enabled (where the WAP is necessary for using the gaming system) to be forwarded to him at another terminal from which he can retrieve the messages, such as forwarding the messages to his email address, to an alphanumeric pager, or to a short message system of the terminal that is not WAP-enabled. This

enables a player to react, such as by returning to a WAP-enabled terminal and logging into the gaming system, if something happens in a game in which he is engaged while he is offline.

Puskala, col. 8, lines 20-31. Appellants assert that these messages that are sent while the player is offline are simply “predefined messages,” not tokens, as recited in claims 1, 13 and 29. Furthermore, merely being able to receive messages while offline does not “allow[] the user to enter token text to replace the at least one token in the message,” as recited in claim 1, or editing at least one token, as recited in claims 13 and 29. Therefore, this cited portion does not rebut the portions of Puskala that teach away from “enter[ing] token text to replace the at least one token in the message,” as recited in claims 1, 13 and 29.

The Examiner similarly asserts that “Puskala further describes messages will be stored at the wireless device (e.g., at data store 58) of terminals 10 or in message database 31 at the Game-complex 47 (server). The user can then retrieve the stored messages at later time without interrupting the game.” Fourth Office Action, pages 15-16. Appellants respectfully submit that even if these portions disclosed that the user could retrieve messages while offline, retrieving messages offline is not “enter[ing] token text to replace the at least one token in the message,” as recited in claim 1, or editing at least one token, as recited in claims 13 and 29.

In support of the Examiner’s assertion, the Examiner cited two portions of Puskala. The first cited portion states:

Game complex 47 (the “game program”) comprises a message database 31 for storing game-related predefined messages and to “open” and recognize codes sent by a player from one of the wireless terminals 10,20 to game platform 40. For example, the message database must recognize that code *5 sent by terminal 10 represents a particular predefined message in message database 31 that is to be sent to predefined destination (e.g. sent message 5 to all players). Game complex 47 further comprises a destination database 32 that stores the predefined destinations where game-related messages are to be sent (e.g., addresses of wireless terminals 10, 20 and addresses of any other game platforms). When a user enters a command to send a predefined message, the command is sent to game platform 40, which receives the command and sends the message to the destination address(es), as previously specified to the game platform 40 in destination database 32 or as specified in the command. Predefined messages may also be stored at mobile terminal 10 in memory 56 and sent from there in which case the predefined message will be sent from mobile

terminal 10 to the game platform 40 for distribution when the command is given to send a predefined message.

Game complex 47 further comprises an event database 33 for storing game-related events that trigger game-related messages (e.g. capturing, beating, killing, hitting, and seeing an opponent during a game), scanning software (or a circuit) 34 that functions as a scanning means for checking the game-related events as they occur and comparing them to contents of event database 33, and control software (or a circuit) 35 for preparing a list of event-related predefined messages to be sent to a player when scanning software 34 indicates a match between an event occurring during the game and the events listed in the event database 33.

Puskala, col. 5, lines 1-33. The second cited portion states that “[d]ata storage 58 can also be used to store and retrieve information about other players and predefined messages.” *Id.* at col. 6, lines 14-16. Appellants respectfully submit that the first cited portion of Puskala and the second cited portion of Puskala merely refer to storing, recognizing, sending, receiving, triggering and preparing “predefined messages.” However, “predefined messages” are not tokens, as recited in claims 1, 13 and 29.

To summarize the Examiner’s responses to Appellants’ remarks of February 13, 2006, the Examiner has merely argued that Appellants’ arguments regarding Puskala teaching away from Martin are of a dubious origin (the Background section of Puskala) and asserted that the fact that Puskala discloses creating predefined messages teaches toward the use of tokens, as recited in claims 1, 13 and 29. Appellants respectfully submit that first, the background section of a prior art reference is an appropriate source for statements that teach away from a proposed combination and second, the use of predefined messages, in offline mode or otherwise, does not teach toward using tokens, as recited in claims 1, 13 and 29.

In view of the foregoing, Appellants respectfully submit the Examiner has not presented a *prima facie* case of obviousness against claims 1, 13 and 29. Therefore, Appellants submit that independent claims 1, 13 and 29 are patentably distinct from the cited references. Accordingly, Appellants respectfully request that these claims be allowed.

Claims 2, 3, 7 and 8 depend either directly or indirectly from claim 1. Claims 14-19, 23 and 24 depend either directly or indirectly from claim 13. Claims 30-34 and 37 depend either directly or indirectly from claim 29. Accordingly, Appellants respectfully request that claims 2,

3, 7, 8, 14-19, 23, 24, 30-34 and 37 be allowed for at least the same reasons as those presented above in connection with claims 1, 13 and 29.

B. Claims 9-12, 25-28 and 38-40 Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 25-28 and 38-40 under 35 U.S.C. § 103(a) based on Puskala in view of Graham. This rejection is respectfully traversed.

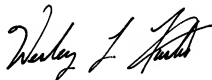
The standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is provided above. Appellants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

As discussed above, Puskala does not disclose, teach, or suggest the use of tokens as recited in claims 1, 13 and 29. Likewise, Graham does not disclose, teach, or suggest the use of tokens. In fact, even if Graham did disclose, teach, or suggest the use of tokens, the proposed combination would be improper because Puskala teaches away from any customization of its predefined messages.

In response to these arguments, the Examiner asserts Graham teaches “HTML-compliant description languages, such as XHTML, HDML and XML. ... The Applicants [sic: Applicants’] arguments, however [sic: ,] are not directed to these claimed elements, instead the arguments are directed to claims 1, 13 and 29 (see the Examiner [sic: Examiners’] response above regarding these independent claims).” Fourth Office Action, page 16. Appellants respectfully submit that Graham’s teachings are irrelevant because Puskala does not teach the use of tokens, as recited in claims 1, 13 and 29 and teaches away from any customization of its predefined messages. The Examiner has not cited, nor can Appellants find any portion of Graham that discloses the use of tokens, as recited in claims 1, 13 and 29.

In view of the foregoing, Appellants respectfully submit that independent claims 1, 13 and 29 are patentably distinct from the cited references. Claims 9-12 depend either directly or indirectly from claim 1. Claims 25-28 depend either directly or indirectly from claim 13. Claims 38-40 depend either directly or indirectly from claim 29. Accordingly, Appellants respectfully request that the rejection of claims 9-12, 25-28 and 38-40 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 13 and 29.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being more prominent and the last name "Austin" written in a smaller, more compact script.

/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Appellant(s)

Date: September 19, 2006

MADSON & AUSTIN
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: (801) 537-1700

CLAIMS APPENDIX

Listing of Claims involved in the appeal:

1. A hand-held wireless telecommunications device configured to send a text message to a recipient through use of a global computer network, the wireless device comprising:
 - a processor;
 - an input component in electronic communication with the processor for a user to enter user input, wherein the input component is capable of entering text;
 - a display in electronic communication with the processor that displays information to the user;
 - a communications module in electronic communication with the processor for communicating with the global computer network;
 - memory in electronic communication with the processor for storing data, wherein the data comprises at least one token;
 - a messaging module comprising instructions that are executable by the processor for implementing a method comprising:
 - connecting the wireless device to the global computer network;
 - displaying network data received from the global computer network on the display;
 - enabling the user to establish communications with a message web site;

providing to the user a message user interface to select a message from a plurality of preconfigured messages, each of the plurality of messages being preconfigured to be sent to a recipient, wherein at least one of the messages is a text message that includes at least one token, wherein the messaging module receives the plurality of preconfigured messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of preconfigured messages, and wherein the messaging module allows the user to enter token text to replace the at least one token in the message;

providing to the user a recipient user interface to select the recipient; and

sending the message to the recipient through the global computer network.

2. The hand-held wireless telecommunications device as defined in claim 1, wherein the hand-held wireless telecommunications device is a mobile telephone.

3. The hand-held wireless telecommunications device as defined in claim 1, wherein the hand-held wireless telecommunications device is a personal digital assistant.

4-6. (Cancelled)

7. The hand-held wireless telecommunications device as defined in claim 1, wherein at least one message is an e-mail.

8. The hand-held wireless telecommunications device as defined in claim 1, wherein the network data comprises WML.

9. The hand-held wireless telecommunications device as defined in claim 1, wherein the network data comprises HDML.

10. The hand-held wireless telecommunications device as defined in claim 1, wherein the network data comprises HTML.

11. The hand-held wireless telecommunications device as defined in claim 1, wherein the network data comprises XML.

12. The hand-held wireless telecommunications device as defined in claim 1, wherein the network data comprises XHTML.

13. A web site for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices, the web site comprising:

- a web server for serving web data to a plurality of wireless devices;
- a computer enabling operation of the web server, the computer being in electronic communication with a storage device storing instructions executable by the computer for implementing a method comprising:
 - allowing a wireless device to contact the web site via a global computer network;
 - receiving from the wireless device a user identification;
 - sending an address list identified through use of the user identification from the web site to the wireless device;
 - sending a plurality of preconfigured messages identified through use of the user identification from the web site to the wireless device, each of the plurality of messages being preconfigured to be sent to a recipient, wherein at least one of the preconfigured messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device;
 - receiving a message and the recipient from the wireless device, wherein the message is selected from the preconfigured messages by a user through the wireless device, and wherein the recipient is selected from the address list by the user through the wireless device; and
 - sending the message to the recipient through the global computer network.

14. The web site as defined in claim 13, wherein the method further comprises storing the preconfigured messages on the storage device.

15. The web site as defined in claim 13, wherein the method further comprises:
sending user interface data to a client computer to present an edit user interface on the client computer; and
receiving a change from the client computer to change one of the preconfigured messages.

16. The web site as defined in claim 13, wherein the method further comprises receiving PIM data from a client computer in electronic communication with the web site via the global computer network and storing the PIM data on the storage device.

17. The web site as defined in claim 13, wherein the method further comprises:
receiving PIM data from a client computer in electronic communication with the web site via the global computer network, wherein the PIM data is for a personal digital assistant transferred to the client computer from the personal digital assistant; and
storing the PIM data on the storage device at the web site.

18. The web site as defined in claim 13, wherein the web server serves the web data to a plurality of mobile telephones.

19. The web site as defined in claim 13, wherein the web server serves the web data to a plurality of personal digital assistants.

20-22. (Cancelled)

23. The web site as defined in claim 13, wherein at least one message is an e-mail message and wherein the method further comprises e-mailing the e-mail message to the recipient through the global computer network.

24. The web site as defined in claim 13, wherein the web data comprises WML.
25. The web site as defined in claim 13, wherein the web data comprises HDML.
26. The web site as defined in claim 13, wherein the web data comprises HTML.
27. The web site as defined in claim 13, wherein the web data comprises XML.
28. The web site as defined in claim 13, wherein the web data comprises XHTML.
29. A method for providing preconfigured messages to a hand-held wireless telecommunications device to be sent to a recipient through use of a global computer network, the method comprising:
 - establishing electronic communication between the wireless device and the global computer network;
 - establishing electronic communication between the wireless device and a web site storing preconfigured messages, each of the messages being preconfigured to be sent to a recipient, wherein at least one of the messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device;
 - retrieving an address list from the web site based on a user identification;
 - sending the address list to the wireless device;
 - providing to a user a recipient user interface to select the recipient from the address list;
 - retrieving the preconfigured messages from the web site based on a user identification;
 - sending the preconfigured messages to the wireless device;
 - providing to the user a message user interface to select a message from the preconfigured messages, wherein if the message includes a token, the message user interface allows the user to input token text; and
 - sending the message to the recipient through the global computer network.

30. The method as defined in claim 29, further comprising providing a client user interface to a client computer via the global computer network to enable the creation of the preconfigured messages that are stored on the web site.

31. The method as defined in claim 30, further comprising receiving PIM data from the client computer in electronic communication with the web site via the global computer network and storing the PIM data on the web site.

32. The method as defined in claim 30, further comprising receiving PIM data from the client computer in electronic communication with the web site via the global computer network, wherein the PIM data is for a personal digital assistant and had been transferred to the client computer from the personal digital assistant, and storing the PIM data on the web site.

33. The method as defined in claim 30, wherein the wireless device is a mobile telephone.

34. The method as defined in claim 30, wherein the wireless device is a personal digital assistant.

35-36. (Cancelled)

37. The method as defined in claim 29, wherein the recipient user interface and the message user interface comprise WML instructions.

38. The method as defined in claim 29, wherein the recipient user interface and the message user interface comprise HTML instructions.

39. The method as defined in claim 29, wherein the recipient user interface and the message user interface comprise XML instructions.

40. The method as defined in claim 29, wherein the recipient user interface and the message user interface comprise XHTML instructions.

EVIDENCE APPENDIX

NONE.

RELATED PROCEEDINGS APPENDIX

NONE.